

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on July 28, 2004. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-29 remain in this application. Claim 30 has been canceled. Claim 31 has been added. The independent claims have been amended to recite previous limitations in means-plus-function format, as discussed at the personal interview.

Claims 1-15, 17-18, 20, and 23-29 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Wang (U.S. 6,175,922) and Bengault (U.S. 2002/0087992). Claims 16 and 19 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Wang and Bengault in further view of French publication to Laurysen (0465456 A1). Claims 21 and 22 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over Wang and Bengault in further view of Orlen (U.S. 5,579,535). For the following reasons, the rejections are respectfully traversed.

First, Bengault is not prior art. The current application has a priority date of July 6, 1999, based on PCT application PCT/CH99/00299, which is international publication number WO 01/03075. An accurate translated copy of this document is provided, as requested by the Examiner. Hence, the rejection is improper for relying on Bengault.

Further, claim 1, as amended, recites a system having "central data processing means including means for checking the passengers travel authorizations". Claims 28 and 31 have similar limitations. Wang, in contrast, teaches a portable authorization device for supporting monetary transactions. This was discussed in detail at the personal interview. It was further discussed that there is no suggestion in Wang for performing travel authorizations. Hence, Wang does not teach the cited element.

Still further, claim 1 recites that the system has "means for distributing information and entertainment programs to said portable terminals for use by the passengers". Claims 28 and 31 also have similar limitations. Wang does not suggest this element of the claim, either.

Consequently, claims 1, 28, and 31 are all patentable over Wang.

Claim 23 recites a method including a step of "checking the passengers' travel authorizations being stored in portable personal terminals adapted for being carried by the passengers" and a step of "distributing information and entertainment programs over the data bus to the passengers". As discussed above for claim 1 and at the personal interview, Wang does not suggest these steps. Thus, claim 22 is patentable over Wang for at least the same reasons as claim 1.

Because neither Lauryssen nor Orlen overcome the shortcomings of Wang, claims 1, 23, 28 and 31 are patentable over those references as well, even if combined with Wang. The remaining claims, which depend, directly or indirectly upon one of claims 1, 23, 28 and 31 are each patentable over those references for at least the same reasons as the parent claim.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references without any proper motivation for the combination, which is what the Examiner is attempting to do.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34183.

Respectfully submitted,

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